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PARFOMAK, ANDREW N. 875 THIRD AVE, 8TH FLOOR NEW YORK, NY 10022				
EXAMINER				
GRESO, AARON J				
ART UNIT		PAPER NUMBER		
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11/06/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/552,655

Applicant(s)

FLACHSMANN ET AL.

Examiner

AARON GRESO

Art Unit

1796

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3, 5, 7-8, 10-15, 18-19 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 3, 5, 7, 8, 11-13, 18 and 19 is/are rejected.
- 7) ☒ Claim(s) 10, 14-15 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S508)
Paper No(s)/Mail Date ____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date ____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: ____

DETAILED ACTION

Any rejections and/or objections made in the previous Office Action and not repeated below, are hereby withdrawn.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

New grounds of rejection set forth below are necessitated by Applicant's amendment filed on 27 July 2009.

Claims 1-2, 4, 6, 9, and 16-17 have been canceled; arguments concerning these are moot {Claim 6 being canceled prior to the last Office action}.

Arguments as to Claims 5, 7-8, 10-15, 5-19 are moot in that the Claims' scopes have been changed due to cancellation or amendments and amendments requiring a change of the scopes of the dependent or amended dependent Claims; new grounds of rejections apply to these claims.

Particularly, Claim 5 has been amended to reduce the applicable claimed materials; Claim 10 has been amended by removing a chemical in the list; both Claim 5 and Claim 10 are redirected to depend upon Claim 3.

Claim 3 has not been amended.

The newly amended claims were not present at the time of the preceding action; the same grounds of rejection are maintained for Claim 3. However, new grounds of rejections are applied.

An address to the Applicants arguments is presented after addressing the Claims.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 3 is rejected under 35 U.S.C. 102(b) as being anticipated by *Meigs* (US 2197479).

Meigs (col 1 lines 15-26 and 45-56 and col 2 lines 2-7), shown in Figure 1 below, discloses a genus of chemicals including those claimed by the Applicant. As indicated, Figure 1 b) shows an alkoxy substituted group (R-O-), with R representing an alkyl cyclic alicyclic saturated or unsaturated group including a straight or branched chain, on the end of a divalent organic radical (R') that can range from ethyl to n-propyl or isopropyl, and cyclohexyl, among a short list of other carbon radicals. This successive chain of the genus-allowed moieties is also attached to a carbamate that comprises a nitrogen that can be attached to on or two hydrogen atoms, or can be attached to one or more carbon radicals where either R² or R³ groups are represented by organic radicals "such as ethyl or methyl" (col 1 lines 25-26).

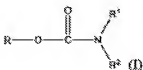


Figure 1 a) Application genus.

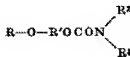


Figure 1 b) *Meigs* genus.

When the reference's R, R' , R² and R³ are respectively represented by ethyl, cyclohexyl, with N,N ethyl and ethyl groups, a chemical with the molecular weight of 29 + 16 + 82 + 16 + 12 + 16 + 14 + 29 + 29, or by summing, a molecular weight of approximately 227 with 12 carbon atoms. With R² and R³ corresponding to the Applicants' R¹ and R², and when R-O-R' is taken as the Applicant's R {where the Applicant's R is thus represented by a cycloalkylalkyl that is optionally substituted with an alkoxy group}, the chemical is readily envisioned within the Applicants' genus.

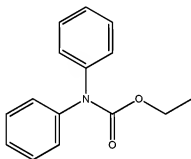
The reference (*Examples I and II col 3 lines 28-66*) provides methods of manufacturing the chemicals in the genus that are indicated to be used for applications in cosmetics and perfumes (*col 4, line 46-47*).

The reference discloses or inherently discloses and encompasses the Application's Claims. Therefore, Claim 3 is rejected.

Claims 3, 7-8, are rejected under 35 U.S.C. 102(b) as being anticipated by *Hunt et al. (US 2460291)*.

Hunt discloses (col 1 lines 3-8) the production of geraniol, a fragrance {see informational reference: Geraniol, the Good Scents Company}; after the fragrance is made, a composition comprising diphenyl urethane is further made that requires adding the geraniol with the diphenyl urethane (col 2 lines 31-34 and col 3 lines 17-26).

Diphenyl urethane is shown in Figure 2 below. It is within the Claim 3 genus and can be readily envisaged when R1 and R2 of Claim 3 are phenyl groups and when R is an ethyl group.



diphenyl urethane

Figure 2. Diphenyl urethane.

The fragrance composition made meets the claim's limitations.

The reference discloses or inherently discloses the requirements for the applicable Claims.

Claims 3, 7-8 are rejected under 35 U.S.C. 102(b) as being anticipated by *Torii et al.* (US 3966903).

Torii et al. discloses compositions for hair waving comprising the following genus chemicals (Abstract) shown in Figure 3 below:



Figure 3. US 3966903 genus>>

In Figure 3, R_1 , R_2 , and R_3 are chosen from a group comprising, methyl, ethyl, and propyl groups. These genus attributes satisfy the instant Claim 3 genus and can be

readily envisaged when R₁, R₂, and R₃ of the reference are each C₁-C₁₁ alkyl groups for the Claim 3 genus group a) for each R, R¹ and R² species.

As to Claims 7-8.

The chemicals are indicated to be combined with other materials including perfumes (col 4 lines 46-52). The compositions are indicated to be used for hair waving (col 1 lines 65-68) and this terminology is taken as indicating uses for hair, as a body care product; compositions are also indicated to be free from any unpleasant odor and this is taken to indicate that the compositions employing the genus chemicals are intended to be used because they have a pleasant smell. {It should be noted that the reference does not indicate that the materials are free from odor.}

The reference discloses or inherently discloses all the limitations of the applicable Claims.

Claim Rejections - 35 USC § 103

Claim 11-13 are rejected under 35 U.S.C. 103(a) as being obvious over *Torii et al.* (US 3966903) in view of Claims 3, 7-8 above.

Further as to Claims 11-13:

The reference does not further disclose employing chemicals in the Claim 11 genus.

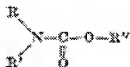
However, Claims 11-13 are rejected under 35 U.S.C. 103 as being obvious in accord with MPEP 2144.09 regarding Homology and Isomerism which states:

"Compounds which are position isomers (compounds having the same radicals in physically different positions on the same nucleus) or homologs (compounds differing regularly by the successive addition of the same chemical group, e.g., by -CH₂- groups) are generally of sufficiently close structural similarity that there is a presumed expectation that such compounds possess similar properties".

When the reference's genus {discussed above} employs substituents where R_1 is propyl, and when R_2 and R_3 are ethyl, a homolog of a chemical in the Structure Table for Claim 11 is indicated. The Structure Table chemical being in the center of page 8 of 21 in instant Claim 11 where when one of the amine alkyl groups is butyl.

It would have been obvious at the time of the invention for one of ordinary skill in the art to have further employed a homolog of the successful chemicals demonstrated by *Torii et al.* and mixed them in compositions comprising perfumes that are indicated to be used for successful body care products that have an odor that is not unpleasant, with a reasonable expectation of success.

Claim 5 is rejected under 35 U.S.C. 103(a) as being obvious over *Jager et al.* (US 3203853).



R = H, alkyl, alkylenyl, cycloalkyl, aralkyl (taken as an aryl group substituted for an alkyl hydrogen) radicals

R' = H, alkyl, alkylenyl, cycloalkyl, aralkyl and substituted Phenyl radicals

R'' = alkyl, alkylenyl, cycloalkyl, aralkyl and substituted Phenyl radicals while also being a phenoxyethyl radical

R and R' may together comprise heterocyclic ring

(Note: the reference indicates, by example, that cyclohexyl is included in the meaning of cycloalkyl (col 3 line 6); lower alkyl groups are also demonstrated as being represented by methyl, propyl, and isopropyl (col 2 lines 4-12)).

Figure 4. *Jager et al.* genus (col 1 lines 45-65).

The reference (col 1 lines 45-65) discloses compositions comprising the applicants' genus shown above in Figure 4. As shown in Figure 4, the reference's R

and R' and R'' equate to the Application's R1 and R2 and R respectively (see Figure 1a).

The reference further demonstrates chemical meanings for the alkyl and phenyl groups that may be substituted, comprising methyl carbamates such as Phenyloxyethyl-N-methylcarbamate and also teaches of using 2-isopropyl-3-methylphenyl-N [,N] diisopropyl carbamate, as well as cyclohexyl-N-methylcarbamate (col 3 lines 3-12). This subclass of examples is taken to demonstrate the chemical functional groups indicated for the genus. The materials are indicated to be non-toxic (col 2 lines 1-4) and the chemicals are shown to be comprised within compositions that include fragranced products (col 4 lines 46-47).

When the reference's R, R' and R'' are respectively methyl, methyl and 2-ethoxy phenyl, an Application chemical is identified (2-ethoxy-phenyl, methyl, methyl, top line, page 5 of 10 of instant Claims). {In addition, when R'' is represented by a cyclohexyl group and both of the references R and R' groups are ethyl, the first chemical in instant Claim 11 is shown}. Also, when a methyl group is substituted for hydrogen of *Jager et al.*'s 2-ethoxy-phenyl N methyl carbamate, allowed for in *Jager et al.*'s genus (col 3, item 7, line 9), resulting in 2-ethoxy-phenyl N,N dimethyl carbamate, a chemical within the list instant Claims 5 and 10 (page 7, 4th line from bottom of page) is identified. The functional groups demonstrated in these chemical examples show that the reference's genus comprises chemicals in the Application's formula I genus and chemicals in instant Claim 5.

The reference readily allows one to envision chemicals named in the Application's Claim 5 when only employing functional groups exhibited in the example group of chemicals in column 3 lines 3-12. These chemicals also qualify as being within the genus of Claim 3.

It would have been obvious to one of ordinary skill in the art at the time of the invention to have derived a successful chemical compound encompassed by the genus of *Jager et al.* comprising the finite number of functional groups in a finite number of positions demonstrated by the example compositions, as suggested by the reference's successful teachings, that reside in the genus and which are compatible for use with perfumes, with a reasonable expectation of success.

Response to Arguments

Applicants' arguments filed 24 July 2009 have been fully considered but they are not persuasive.

Addressing arguments regarding 3:

1) Applicants argue: *Meigs (US 2197479)* does not disclose all limitations of Claim 3.

As to Claim 3: Chemicals in the genus disclosed by *Meigs* (col 1 lines 18-56 and col 2 lines 1-16) are indicated to have applications in perfumes and cosmetic (col 4 lines 46-47) compositions.

Further, Claim 3 is a Composition Claim. Although the compositions are indicated to be "generally odorless" (col 2 lines 17-18) and free from substantial odor

(col 4 lines 50-52); this does not preclude odor for all chemicals within the instant Claim 3 genus. Further, an odor is inherent to a chemical.

In accord with MPEP 2112.01: "Products of identical chemical composition can not have mutually exclusive properties. Therefore, if the prior art teaches the identical chemical structure, the properties applicant discloses and/or claims are necessarily present. *In re Spada*, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990)".

In addition, it should also be noted that a recitation of the intended use of the claimed invention must result in a difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art material or structure is capable of performing the intended use, then it meets the claim. It has been held that a preamble is denied the effect of a limitation where the claim is drawn to a structure and the portion of the claim following the preamble is a self-contained description of the structure not depending for completeness upon the introductory clause. *Kropa v. Robie*, 88 USPQ 478 (CCPA 1951); *Ex parte Masham*, 2 USPQ2d 1647 (1987). Recitations of intended use are similarly denied the effect of a limitation. *In re Pearson* 181 USPQ 641

The rejection for Claim 3 by Meigs stands.

Allowable Subject Matter

Claims 10 and 14-15 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter: The specific functional groups with specific locations indicated by Claim 10 in the table are not found after a thorough search of the art.

Of the applicable art, the closest is *Troii et al.* (US 3966903). This reference employs carbamate material in fragranced body care compositions (col 1 lines 65-68 and col 4 lines 46-52) that do not have unpleasant odors which comprise genus chemicals is lacking in the extent of substituents. The genus of Formula II in the reference's Abstract indicates that the carbamates can only comprise methyl, ethyl or propyl groups; combinations of these groups fail to satisfy the limitations of the applicable claims; extension of homologous arguments are also not determined to be sufficient to cover hexyl groups in Claim 11 and its dependent claims 14-15.

Examiner Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to AARON GRESO whose telephone number is (571)270-7337. The examiner can normally be reached on M-F 0730-1700.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on 571 272 1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/James J. Seidleck/
Supervisory Patent Examiner, Art Unit 1796

AJG